

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: August 3, 2005

Opposition No. 91163746

MEDTRONIC, INC., and  
PACESETTER, INC. D/B/A/ ST.  
JUDE MEDICAL CARDIAC RHYTHM  
MANAGEMENT DIVISION

v.

CARDIAC PACEMAKERS, INC.

Nancy L. Omelko, Interlocutory Attorney:

**Background**

On March 4, 2005, the parties submitted a paper entitled "Joint Submission and Stipulation" which attempted to address seven opposition proceedings involving four applications and three opposers or combinations thereof.

The relevant portion of the stipulation reads as follows:

First, the parties request consolidation of the two oppositions that have been filed against application Serial No. 76/535,842 for the mark PACEMAKERPLUS. The numbers of these oppositions are 91161441 (filed by Medtronic) and 91161301 (filed by Pacesetter, Inc. doing business as St. Jude Medical Cardiac Rhythm Management Division).

Second, the applicant no longer has a *bona fide* intent to use the marks:

1. PACERPLUS (Application Serial No. 76/535,841) which is the subject of Opposition No. 91163746 filed jointly by Medtronic, Inc. and Pacesetter, Inc.

2. PACER+ (application Serial No. 76/535,840) which is the subject of Opposition No. 91161444 filed by Medtronic, Inc. and Opposition No. 91162106 filed by Pacesetter, Inc.

3. PACEMAKER+ (Application Serial No. 76/536,437) which is the subject of Opposition No. 91161126 filed by Pacesetter, Inc. and 91161204 filed by Medtronic.

In view of the foregoing, applicant expressly abandons the PACERPLUS (Application Serial No. 76/535,841); PACER+ (Application Serial No. 76/535,840) and PACEMAKER+ (Application Serial No. 76/536,437) applications.

Third, the parties wish to note that answers have been filed in connection with the two oppositions that remain (i.e., Oppositions Nos. 91161441 and 91161301) related to the PACEMAKERPLUS application.

Fourth, the parties agree that Opposition Nos. 91161441 and 91161301 involve common questions of law and fact. Medtronic and St. Jude have both opposed Applicant's application to register PACEMAKERPLUS on the same grounds, i.e., alleging that the mark is a generic term and/or merely descriptive. The parties also agree that consolidation of these proceedings will save time, effort, and expense. Accordingly, the parties request that the Board consolidate these actions.

The parties further stipulate and agree that the Board should adopt the following discovery, testimony and briefing dates in the consolidated case:  
(Dates Provided).

On April 1, 2005, the Board issued an order wherein the Board indicated that applicant filed an abandonment of its application Serial No. 76535840 with opposer's written consent; and ordered that the application stands abandoned; and that the opposition is dismissed without prejudice.

This case now comes up on opposer's request (filed April 22, 2005) to amend the Board's order "dismissing" the

application with prejudice. Specifically, opposer asserts that it did not consent to the abandonment.

In response, applicant argues that by signing the joint stipulation, counsel for opposers consented to the written abandonment of the applications. Furthermore, the stipulation that was signed by counsel for opposers made no reference as to whether the abandonment should be with or without prejudice and does not indicate anywhere that the consent was in any way conditioned upon the entry of judgment against the applicant with prejudice with respect to the abandoned marks.

The Board has, in its discretion, considered opposer's reply brief, in which opposer argues that the parties intended that applicant's abandonment of the involved application was without opposer's consent. Opposer has submitted a copy of a draft of the agreement which shows the language concerning consent lined through, as shown below:

~~In view of the foregoing, applicant, with the consent of the Opposers as indicated by the signature of their attorneys provided below, expressly abandons the PACERPLUS (Application Serial No. 76/535,841); PACER+ (Application Serial No.76/535,840) and PACEMAKER+ (Application Serial No. 76/536,437) applications. The parties request that the oppositions related to the applications therefore be dismissed.~~

As such, it is apparent that opposers did not intend to give their consent to the abandonment. Accordingly, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused. We hasten to add that opposers cannot get judgment on an unpleaded

ground which, in this case, is that applicant no longer has a bona fide intent to use the mark in commerce.

***By the Trademark Trial  
and Appeal Board***